REMARKS

Applicant hereby traverses the current rejections of record, and requests reconsideration and withdrawal in light of the remarks contained herein. Claims 14-36 are pending in this application.

Rejection Under 35 U.S.C. § 112

The Current Action rejects claims 21-36 for failing to comply with the enabling requirement of 35 U.S.C. § 112, first paragraph. Specifically, the Examiner asserts that the claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention. The Applicant respectfully submits, however, that the specification as originally filed, enables claims 21-36.

With respect to claims 21, 26, and 31 the Examiner states that the specification does not contain "the code retrieved from the device for identifying the type of device is executable code." The Applicants remind the Examiner that the description of a software element's function (i.e., identifying the type of device) is considered adequate for enablement under M.P.E.P. § 2106.01, because one of ordinary skill in the art is capable of writing code to fulfill that function. "As a general rule, where software constitutes part of a best mode of carrying out an invention, description of such a best mode is satisfied by a disclosure of the functions of the software . . . [t]his is because, normally, writing code for such software is within the skill of the art." M.P.E.P. § 2106.01 citing *Fonar Corp. v. General Electric Co.*, 107 F.3d 1543 (Fed. Cir. 1997). The software function with regard to claims 21, 26, and 31 is sufficiently detailed in the specification to enable its use by one of ordinary skill in the art. (*See* pgs 7 and 8). Therefore, the Applicants respectfully request that the 35 U.S.C. § 112 rejection of claims 21, 26, and 31 be withdrawn.

With respect to claims 22 and 30, the Examiner states that "the specification never refers to a SysObjID." However, the Applicants respectfully point out that system object ID (or SysObjID) is explicitly referred to at page 6 (2nd paragraph), among other places, in the specification.

Finally, claims 23-25, 27-30, and 32-36 are rejected for including the non-enabled subject matter of the claims from which they depend. In view of the remarks above, that is, Applicant's arguments regarding the enablement of claims 21, 22, 26, 30, and 31, Applicant submits each of claims 23-25, 27-30, and 32-36 are also enabled.

Rejection under 35 U.S.C. § 103(a)

Claims 14, 15, and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,122,639 to Babu et al. (hereinafter "*Babu*").

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Without conceding the first or second criteria, the Applicants respectfully assert that the Current Action fails to establish a prima facie case because the Examiner's proposed combination fails to teach or suggest all of the Applicants' claimed limitations.

Claim 14 recites a method for discovering a type of device that includes the step of "calling a method of each created object, wherein said method is operable to determine whether a device associated with said I/O path is the type of device described by the property file associated with the said object method." *Babu* does not teach this element. *Babu* teaches merely "obtaining a device type identifier from the device." (*Babu* col. 2, lines 64-65). *Babu* does "[look] up the device type identifier in a device type table stored in the database." (*Babu* col. 3, lines 8-9). However, this step does not determine whether the device is the type of device described by the property file associated with the said object method, as the Current Action contends at page 4. When *Babu* performs this step, the device type has already been determined. In an attempt to cure this defect, the Current Action opines that elements 302-314 of *Babu* "retriev[e] property files from a directory where the property files describes a type of device." The Applicants respectfully point out, however, that even if true, such a showing would not meet the elements of the claim. Claim 14 is a method "for discovering a type of device associated with an input/output (I/O) path of a storage area network."

Elements 302-314 in *Babu* could not be used for discovering the type of device because the device type is the very information these steps of *Babu* use to obtain the device type identifier. *Babu* does not, therefore, teach or suggest every element of claim 14. The Applicants assert that the Current Action has filed to establish a prima facie case of obviousness and respectfully request that the Examiner withdraw the rejection of claim 14.

The Office Action rejects claims 15 and 17 as unpatentable over *Babu* alone, and rejects claim 16 as unpatentable over *Babu* in light of U.S. Patent App. 2002/0161852 to Allen et al (hereinafter "*Allen*"). However, as dependants of claim 14, claims 15-17 inherit all of the limitations of claim 14. As stated above, *Babu* does not teach all of the elements of claim 14, thus, the Applicants respectfully request that the Examiner withdraw the rejection of claims 15 and 17. Further, because *Allen* does not appear to teach the absent limitations either, the Applicants also respectfully request that the Examiner withdraw the rejection of claim 16.

The Current Action rejects claim 18 as unpatentable over *Babu* in light of *Allen*. However, the Applicants respectfully assert that the Current Action fails to establish a prima facie case for rejecting claim 18 as well. Claim 18 recites a system for analyzing input/output paths that includes:

> a management server process, wherein said management server process is operable to receive gathered device information from said plurality of host agent processes and from said SNMP manager process; and wherein said management server process is operable to call code identified by property files with gathered device information as arguments to thereby identify types of devices associated with I/O paths of said SAN.

Babu does not teach such a management server. *Babu* does send "an SNMP Query For a system object identifier to the network . . . and [test] whether the device is discovered in the network." (*See Babu* col. 3, lines 47-49). However, this step does not identify types of devices, as the Current Action apparently claims at page 5, because when this step is performed in *Babu,* the device type has already been determined. Moreover, it would be illogical to interpret this "test" step as identifying types of devices. Because the type of device "appears to be the very information of *Babu* uses to perform the "test." *Allen* does not

appear to teach this element either, and indeed, the Current Action does not rely on it to do so. The combination of *Babu* and *Allen* do not, therefore, teach or suggest every element of claim 18. As such, the Applicants assert that the Current Action has failed to establish a prima facie case of obviousness and respectfully request that the Examiner withdraw the rejection of claim 18.

Claim 18 also recites:

> a plurality of property files stored in a predefined directory,
> wherein each property file of said plurality of property files describes a
> type of device, and wherein each property file of said plurality of property
> files includes an identifier of code operable to determine whether a device
> associated with an I/O path is the type of device described by its
> associated property file

The Applicants respectfully assert that the proposed combination also fails to teach this limitation. In trying to meet this limitation, the Current Action attempts to equate "property files" with the element 310 of *Babu*. However, the element 310 is not a "property files" because, among other things: a) element 310 comes from the device itself, not from a predefined directory; and b) element 310 does not appear to contain "code operable to determine whether a device associated with an I/O path." Although not relied upon to do so, *Allen* does not teach this limitation either. Thus, the combination of *Babu* and *Allen* does not teach or suggest all of the limitations of claim 18. Therefore, the Current Action has failed to establish a prima facie case of obviousness. The Applicants respectfully ask the Examiner to withdraw the rejection to claim 18.

Claims 19 and 20 depend directly or indirectly from claim 18, and thus inherit all of the limitations of claim 18. Because claims 19 and 20 contain limitations not disclosed by *Babu* and *Allen*, the Applicants respectfully submit that claims 19 and 20 are patentable over *Babu* and *Allen,* and respectfully requests that the Examiner withdraw the rejection.

Although the motivation for combining the cited references has not been addressed, the Applicants do not concede that any of the combinations used in the Final Action are proper. The Applicants merely contend that the Examiner has yet make a prima facie case

for rejecting any of the claims rejected under 35 U.S.C. § 103(a), and that any specific arguments regarding motivation would be premature.

Conclusion

In view of the above amendment, applicant believes the pending application is in condition for allowance. Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 08-2025, under Order No. 10004560-1 from which the undersigned is authorized to draw.

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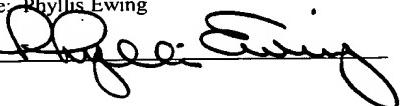
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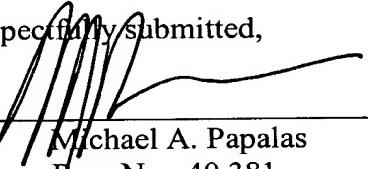
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